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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,209	12/28/2005	Andreas Pein	102134-18	5099
27388 7590 06/23/2009 NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
TREYGER, IL'YA Y				
ART UNIT		PAPER NUMBER		
3761				
MAIL DATE		DELIVERY MODE		
06/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,209

Applicant(s)

PEIN, ANDREAS

Examiner

ILYA Y. TREYGER

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 6 and 10 are amended.
2. Claims 6-10 are examined on the merits.

Response to Arguments

3. Objection of claim 10 has been withdrawn based on Applicant's Remarks, page 5, lines 5-8.
4. Applicant's arguments filed 12/23/2008 have been fully considered but they are not persuasive.
5. With respect to claim 6, Applicant argues that Takasu does not anticipate the claimed invention because the reference does not disclose a vacuum pump and a supply pump, as recited in the amended claim 6, neither does Takasu teach a surgical hand piece with an inner injection cannula and an outer suction tube.

However, Takasu discloses a vacuum pump (Abstract, line 17), a surgical hand piece (10, 20) with an inner injection cannula (10) and an outer suction tube (30). Regarding the term "supply pump", since the apparatus comprises the water supply system (Col. 3, lines 10-13), the supply pump is necessarily present.

6. With respect to claims 7 and 8, Applicant argues that the combination of references is improper because the apparatus of Takasu is intended for being operated with ultrasound.

However, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Since combination of references discloses

substantially the same structure, as that claimed by applicant, the structure is fully capable of performing the claimed function.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Takasu (US 5,236,414 A).

Takasu teaches surgical device for injecting a fluid and/or for removing tissue cells from a biological structure, comprising:

(a) a supply device (37) including a vacuum pump (Abstract, line 17), a fluid jet unit for injecting a separation fluid or a process fluid and/or including a suction device for suctioning off separated or dissolved tissue cells and/or the separation fluid or the process fluid, and

(b) a surgical hand piece (10, 20) with an inner injection cannula (10) and an outer suction tube (30), both of which form an annular suction channel in the region of the surgical hand piece (10, 20), wherein the outer suction tube (30) is capable of being placed on the injection cannula (10) and to be secured to the surgical hand piece (10, 20), and wherein the injection cannula (10) includes a front nozzle opening (12, 13) and the suction tube (30) includes a plurality of suction bores (34, 35) distributed along its periphery, and

Regarding the terms "injection cannula" and "suction tube", the inner and outer tubes (10, 30) of Takasu are each capable of injecting or suctioning fluids when connected to a source of positive or negative pressure.

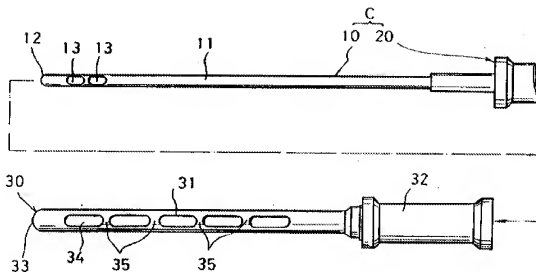


Fig. 2

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

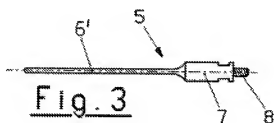
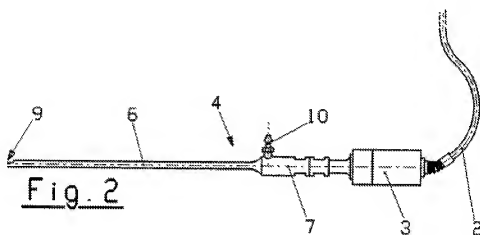
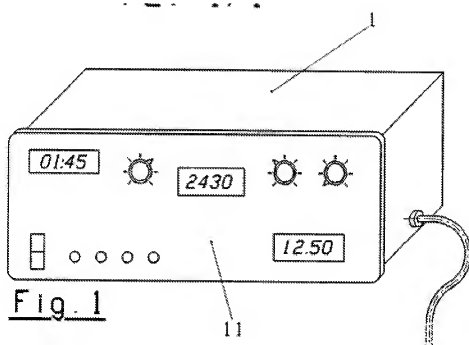
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takasu in view of Boutboul (FR 2 700 958 A1).

Takasu does not expressly disclose additional complementary handles.

Boutboul teaches a liposuction system that has replaceable/interchangeable handles (7) that can be replaced as they become contaminated or to accommodate different sizes of cannulas (6, 6') (see figures 2 & 3, *infra*).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to add additional interchangeable handles to the system of Takasu as taught by Boutboul in order to provide a readily available sterile replacement should a handle in use be damaged or contaminated.



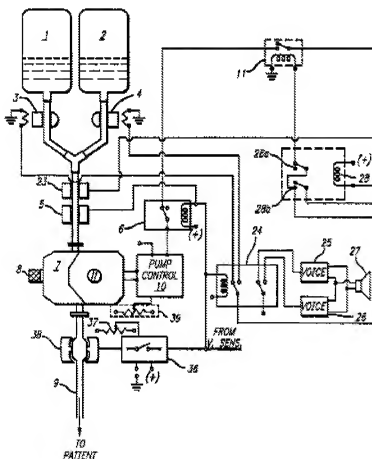
10. Regarding claim 8, Takasu teaches that the inner cannula (10) clears the outer tube (30).

Boutboul teaches interchangeable cannula having different lengths (see figures 2 and 3, supra).

11. Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Takasu in view of Comesu (US 5,836,909 A) and Butsch *et al.* (US 7,063,713 B1; hereinafter “Butsch”).

Takasu does not teach a switchable control valve.

Comesu teaches a system comprising a supply pump (7) and multiple irrigation fluid sources (1, 2) selected by a switchable valve system (3, 4, 5, 6, 24)(col. 5, lines 57-67). This provides for either increased capacity over a single source of irrigation source and/or allows multiple types or irrigation sources (see fig. 2-1, *infra*).



Butsch teaches a liquid jet apparatus comprising multiple reservoirs (1) where the liquid source is controlled by a switched directional valve (11). This is a simpler design than Comescu's multiple valve setup.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to add the multiple reservoirs of Comesu and the switchable directional valve of Butsch to the device of Takasu in order to provide increased capacity over a single source of irrigation source and/or allows multiple types or irrigation sources and to further provide simple switching between the two sources.

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007)(citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions

resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Allowable Subject Matter

12. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The most relevant art of record, Takasu, does not teach or fairly suggest making the inner canulla (10) longer than the outer tube (30) and providing a from axial bore in the outer tube (30) that clears the inner canulla (10). Takasu has a tube (30) with a rounded leading end (30) that is designed to avoid tissue trauma. Opening a bore at that position would negatively affect this functionality.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILYA Y. TREYGER whose telephone number is (571)270-3217. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ilya Y Treyger/
Examiner, Art Unit 3761

/Michele Kidwell/
Primary Examiner, Art Unit 3761